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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,565	01/29/2004	Donald R. Gearhart	12195-004	5093

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EXAMINER

MUSSER, BARBARA J

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/767,565

Applicant(s)

GEARHART, DONALD R.

Examiner

Barbara J. Musser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11,13,14,21 and 24-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 11,13,14,21 and 24-32 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The Declaration filed on 10/02/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Benninger reference.
2. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Benninger reference. The declaration only shows evidence a mold or tooling has been ordered. This is not evidence that applicant's process, including the use of two tools, i.e. the forming tool and the vacuum fixture, the application of the cover over the substrate, and the use of a porous substrate would known prior to the filing date of the reference.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 11, 13, 14, 21, and 24-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11, it is unclear what is meant by the maintaining tension step as it appears to be maintaining the tension of the sheet, i.e. before it is formed into the substrate, while Figure 7 is a flowchart, and flowcharts are considered to show the order of steps, which indicates the maintaining of the tension occurs after the formation of the substrate. The sheet as originally applied to the mold appears to be a simple flexible

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layer. Laying it loosely on top of the retaining portions[0006] would not shape the sheet into having retaining portions at its edge which hold it in the mold during molding. It is unclear how this loose sheet could have retaining portions without the molding having started to occur, and thus the sheet having become a substrate. The process step of maintaining the tension does not appear to occur without the formation of retaining portions, and it is unclear how these are formed before the molding. For the purposes of examination, this step is considered to mean the substrate is retained in some manner at its periphery between the first and second mold portions after molding. This is considered to include the periphery being formed into a shape which would hold it on the mold.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11, 13, 14, 21, 24-26, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al.(U.S. Patent 5,932,331) and Benninger(U.S. Publication 2004/0217523).

Jones et al. discloses a trim panel made of a porous felt substrate(48) which is bonded to a cover laminate(42-46). The panel has a shape at the edges(the top hooked region near 30) such that it would maintain tension on the sheet while it is

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molded.(Figure 2) The reference does not disclose how the trim panel is made.

Benninger disclose a method of making a trim panel by heating a porous substrate between first and second mold portions, applying pressure to form the sheet into a substrate, positioning the substrate on a vacuum fixture, disposing a cover on it with adhesive therebetween, heating the cover and adhesive, and vacuum forming it to the substrate.([0011]-[0018]) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use this method to form the trim panel of Jones including an adhesive between the cover and the substrate since Jones does not disclose how the panel is formed and since Benninger discloses this method allows deep draws and sharp angles to be formed in the trim panel without the risk of tearing the cover laminate[0020] and to use an adhesive between the cover and the substrate as suggested by Benninger since this would bond the layer together preventing them from moving relative to one another. Since the adhesive is heated, i.e. soft, when the vacuum is pulled, one in the art would appreciate that the adhesive would be drawn into the pores of the substrate since the vacuum is pulling on a softened adhesive film. Since the mold is intended to form the substrate into the shape in Jones et al., it would have a shape corresponding to that of Jones et al., i.e. it would have a C-shaped section near 30 and a curve at the bottom such that the mold would have a retaining portion at its periphery which would retain the sheet in the mold during molding.

Regarding claims 13 and 14, while Benninger is silent as to the temperature and pressure at which the substrate is molded, one in the art would appreciate that it would be molded at the same temperature ranges and pressures as applicant's since they are

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making the same type of article as applicant and therefore would be made of the same types of materials.

Regarding claims 21 and 30, Jones et al. discloses the substrate is felt but does not describe it further. Benninger discloses the substrate can be Azdel[0011], which comprises 55% glass fiber and 45% polypropylene, as indicated by applicant.[0019] It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the substrate of Jones et al. from Azdel instead of felt since this would allow air to be pulled through easily as is desired by the method of Benninger.

Regarding claim 24, while Benninger is silent as to the temperature to which the adhesive is heated, the temperature chosen would have been within the purview of one in the art since the types of materials used in trim panels and their melting temperatures are well-known in the trim arts.

Regarding claim 25, Benninger discloses an adhesive film can be applied between the cover and the porous materials[0016]

Regarding claim 26, Benninger is silent as to whether the adhesive film is laminated to the cover material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the adhesive to the cover laminate so that only one layer would need to be positioned on the substrate.

Regarding claim 28, Jones shows a portion of the edges of the trim panel have a general C shape, indicating that the retaining edges of the mold portions would have a generally C shape.(Figure 2, near 30)

Regarding claim 29, while the references do not disclose the clearance between mold sections in various locations, these appear to be conventional clearances between the mold portions.

Regarding claim 31, while Benninger discloses trimming the substrate after molding, one in the art would appreciate it could alternatively be performed before molding, and that only the expected results would be achieved.

Regarding claim 32, Benninger discloses trimming after molding[0014]. Jones discloses a pocket(31) which would clearly be considered an attachment which would have been joined after molding.

### ***Response to Arguments***

7. Applicant's arguments filed 10/2/06 have been fully considered but they are not persuasive.

Regarding applicant's argument that one in the art would understand what is meant by freely retained, examiner is unclear when this step is occurring as sheet indicates it occurs when the layer is a sheet, i.e. before molding, while the flowchart indicates it occurs when the layer is a substrate, i.e. after molding. If its purpose is to retain the sheet in place during molding(as suggested by the specification), it would appear that the retaining portions would need to be formed before molding, but there is no step or suggestion in the specification suggesting such.

Regarding applicant's declaration, it does not show reduction to practice of the invention, but only the purchase of a mold. Molds with retaining portions are known as shown in the PCT search. The purchase of a mold does not show the steps of the

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claimed invention, i.e. the use of a porous substrate, the use of a vacuum fixture in addition to the mold, the application of the cover to the substrate. The declaration does not even include a drawing of the mold purchased so that examiner can determine that it is a mold that meets applicant's claimed limitations to the mold.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone



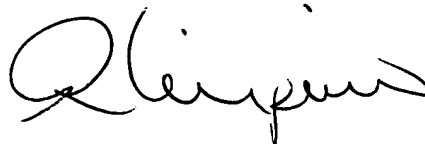
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



BJM



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